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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,652	05/31/2001	Michael Anthony Sijacic	06502.0340	7976
22852	7590	05/19/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				MCALLISTER, STEVEN B
ART UNIT		PAPER NUMBER		
		3627		

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,652	SIJACIC ET AL.	
	Examiner	Art Unit	
	Steven B. McAllister	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 February 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-23,26-32 and 34-68 is/are pending in the application.
- 4a) Of the above claim(s) 15-20,26-30 and 35-68 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-14,21-23,31,32,34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1,3-23,26-32 and 34-68 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

Newly amended claims 31, 32 and 34 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Original claims 1-14, 21-25, and 31-34 (as well as presently pending claims 1, 3-14, and 21-23) are drawn to Species I, shown in Fig. 4A providing for hierarchical invoice approval/dispute and dispute resolution with the vendor. Species II, drawn to no figure, but described in paragraph 0115, is an iterative method of invoice approval and dispute resolution.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31, 32 and 34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Although claims 31, 32 and 34 are withdrawn as discussed above, in order to promote compact prosecution, they will be treated below regarding 35 USC 101, 35 USC 112, and 35 USC 103, but only as that which has already been applied to the claims and that which is old and well known. The examiner presents this information as a courtesy and in way admits that the subject matter of the claims is not distinct and properly withdrawn. The examiner further does not waive the election by original presentation by doing so.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-14, 21, 23, 31, 32, and 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method claims lack a technological element. It is acknowledged that Applicant amended the claim preambles to include “computer-implemented”, but no recitation of a computer in the body of the claims exists to provide a positively recited nexus.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3, 4, 7-9, 31, 32 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 1, 3 and 4, Applicant has amended claim 1 to recite that the "first approver generates the first approver's decision *based on an indication that* the one or more items have been reviewed by one or more other approvers...".

As understood by the examiner, the specification shows that the first approver may receive the invoice after it is reviewed by one or more other approvers, but the specification does not appear to describe that the first approver makes his decision based on the fact that the items have been previously reviewed.

As to claims 7-9, Applicant has amended claim 7 to recite "the first person disputes the line item *in response to receiving an indication reflecting that* the line item has been reviewed by a second person ..."

As understood by the examiner, the first person reviews and acts on the line item in response to receiving the indication, but does not dispute based on the indication that it has been reviewed since the first person can override both approvals and disputes made by previous reviewers.

As to claims 31, 32 and 34, Applicant has amended claim 31 to recite "the second decision being based on the first decision data".

As understood by the examiner, the specification shows that a first approver may receive the invoice after it is reviewed by one or more other approvers, but the specification does not appear to describe that the first approver makes his decision based on the first decision data. The second approver has the ability to override or approve the dispute or approval.

As to claim 32, Applicant has amended the claim to recite that the first individual decides "to dispute the one selected line item *based on the second decisions data;*" However, the specification as understood by the examiner does not describe that the first person's decision to dispute is based on the second decision data (see e.g., Par. 0115 of the spec.).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9, 32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7-9 recite a "first processing entity" and a "second processing entity". However, it is not clear what these entities are intended to be.

Claim 32 is unclear because it recites notifying the first individual of the purchasing entity's decision, but it appears that it should be notifying the first individual of the providing entity's decision.

Claim 34 is indefinite because it depends from claim 33 which is canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, and 6 are rejected under 35 U.S.C. 103(a) as obvious over Randell et al (2002/0198830) in view of Randell et al (2002/0194127)/Remington, incorporated by reference.

'830 shows providing information of disputed invoices to a providing entity; receiving a response from the providing entity reflecting whether the dispute is approved; sending a notification to the buying entity; and performing a resolution process between the buyer and provider after disapproval of the disputed items, comprising allowing the dispute to be placed again via electronic communication (e.g., par. 0063, Fig. 4). '830 does not explicitly show that the disputed line items have been reviewed by different approvers hierarchically. '127/Remington shows this element. It would have been obvious to one of ordinary skill in the art to modify the method of '830 by providing for such line items in order to facilitate dealing with multiple approvers.

Claims 1, 3, 4, and 10-13 are rejected under 35 U.S.C. 103(a) as obvious over Randell et al (2002/0194127) and Remington (incorporated by reference into '127) in view of Gonen-Friedmand et al (2001/0047332).

'127 shows receiving a request from a first approver comprising an authorizer to access invoice data reviewed by a second approver comprising an approver (each invoice having a plurality of line items as shown in Remington); providing the data to the

approver (see e.g., par. 007, 0010); receiving a response reflecting a decision to dispute (e.g., as shown in Remington) wherein the first approver generates the decision based on an indication that the line items of the invoices have been reviewed by other reviewers (e.g., '127 pars. 007, 0010, 0013, and Remington). '127/Remington does not explicitly show performing a dispute resolution process between the purchaser and provider in response to an indication that a line item has not been approved. '332 shows this step. It would have been obvious to one of ordinary skill in the art to modify the method of '127/Remington by performing the dispute resolution process of '332 in order to resolve the billing disputes.

As to claim 3, it is noted that '127/Remington in view of '332 show all elements (see e.g., Figs 8 and 9 of Remington).

As to claim 4, it is noted that '127/Remington in view of '332 shows receiving a response reflecting whether the items approved by the second approver are approved by the first approver.

As to claim 10, '127 shows sending a notification to a first approver comprising an authorizer associated with a purchasing entity, the notification comprising electronically routing the invoice to the authorizer after the approver has reviewed the invoice (e.g., par. 0014); receiving a request from the authorizer to access the invoices; generating an in-box and making it available to the authorizer (see e.g., Fig. 5A); receiving a selection of a first invoice wherein at least a line item has been reviewed (it is noted that review of individual line items is treated in Remington); receiving an

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indication reflecting approval of a line item (in view of Remington's dealing with approval or disputing specific line items). '127/Remington does not explicitly show performing a dispute resolution process between the purchaser and provider in response to an indication that a line item has not been approved. '332 shows this step. It would have been obvious to one of ordinary skill in the art to modify the method of '127/Remington by performing the dispute resolution process of '332 in order to resolve the billing disputes.

As to claim 11, it is noted that '127/Remington in view of '332 shows all elements.

As to claim 12, '127/Remington in view of '332 provides all elements except providing a direct resolution process specifically upon a disapproval of the dispute. However, it is notoriously old and well known in the art to provide a resolution method upon rejection of a dispute, such as escalation of the matter to a higher level of management or to arbitration.

As to claim 13, '127/Remington show all elements of the claim except receiving a second notification reflecting whether the disapproval of the entry has been approved by the provider. '332 shows providing a communication reflecting whether the dispute has been approved. It would have been obvious to one of ordinary skill in the art to modify the method of '127 by providing a communication reflecting the approval status in order to clarify the status of the dispute to the purchaser.

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over 127/Remington in view of '332 as applied to claim 10 above, and further in view of Randell et al (2002/0198830).

As to claim 12, '127/Remington in view of '332 show all elements except facilitating a direct resolution process between the provider and purchaser if the provider does not approve the first approver's dispute. '830 shows providing for facilitating a direct resolution process between the provider and the purchaser (comprising filing another dispute) upon any resolution of the dispute, and therefore it provides for a direct resolution when the provider disapproved the dispute.

Claims 7-9 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonen-Friedman et al ('332) in view of Randell et al (2002/0194127)/Remington.

'332 shows a receiving an indication of a disputed line item by a first person in a first entity, the invoie having a plurality of line items; sending the information to the second entity; receiving a response from the second entity, where the second entity comprises a resolving entity, and where the response is a disapproval of the dispute; and sending notification to the first entity. '332 does not show that the first person disputes the line item in response to receiving an indication that the line item has been reviewed by a second person associated with the first entity. '127/Remington show this element. It would have been obvious to one of ordinary skill in the art to modify the

method of '332 by providing a routing approval system as taught by '127/Remington in order to ease use of the method where plural approvals are required.

As to claim 21, '332 shows receiving an indication reflecting whether the disputed line item is valid; updating a status of disputed line item based on the indication; and making the status available to the purchasing entity (see e.g., Fig. 4). '332 does not show receiving an indication of a disputed line item; assigning the invoice to a first person of the purchasing entity; or that the status is made available to a second entity. '127/Remington shows receiving an indication of a disputed line item from a user associated with the purchaser, assigning the invoice to a first person of the purchasing entity (who is not the "user" above); and a second user receiving the status. It would have been obvious to one of ordinary skill in the art to modify the method of '332 as taught by '127/Remington in order to better facilitate interaction with a plurality of approvers.

As to claims 22, '332 in view of '127/Remington show generating an email (see e.g., par. 0042 of '332).

As to claim 23, '332 in view of '127/Remington show setting the status to invalid. (see e.g., Fig. 4 of '332).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over '332 in view of '127/Remington as applied above, and further in view of '830.

'127 shows providing information reflecting an invoice (Remington shows it contains a plurality of entries); receiving an indication that an entry has been disputed (as in Remington), having been reviewed by a plurality of persons in a hierarchical fashion (as in '127). '127/Remington do not show providing a response whether the provider approved the dispute, or receiving a notification that the purchaser has maintained the dispute. '332 shows providing a response as to approval status. It would have been obvious to one of ordinary skill in the art to modify the method of '127 by providing a status message in order to clarify the communications. '830 shows receiving a notification reflecting that the purchaser has maintained the dispute, comprising refiling of the dispute. It would have been obvious to one of ordinary skill in the art to further modify the method of '127 by providing for a notification reflecting the maintaining of the dispute in order to clarify the purchaser's position and to provide another opportunity to review the case.

Claim 31 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over '127/Remington.

'127/Remington show all elements of the claim as previously discussed, including presenting the first individual with data reflecting the second decision by the second individual since the approver can see decisions made by both the approver and the authorizer.

Alternatively, '127/Remington show all elements except presenting the first individual with data reflecting the second decision by the second individual. However,

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to do so is notoriously old and well known in the art. For instance where an approval is overturned, it is common to notify the previous approvers. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate better communication within the organization.

Claims 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over '127/Remington.

'127/Remington show all elements except receiving third decision data by the providing entity and notifying the first individual of the decision. However, receiving third decision data reflecting a decision by the providing entity to approve or reject the first individual's dispute and providing notification of the decision is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to process and communicate the results of the dispute process.

As to claim 34, '127/Remington show all elements except that the second decision data reflects the second individual's decision to approve or dispute the first decision by the first individual. However, this is notorious old and well known in the art. It would have been obvious to one of ordinary skill in the art to have second decision data reflecting the second individual's decision to approve or dispute the first decision by the first individual in order to facilitate hierarchical approval structures within an organization.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven B. McAllister
Primary Examiner
Art Unit 3627

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STEVE B. MCALLISTER
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